

REMARKS

The final Office Action dated June 5, 2008 has been received and carefully considered. Claims 1, 12, 18, 24, and 42 have been amended. Entry of the amendments to claims 1, 12, 18, 24, and 42 is respectfully requested. Reconsideration of the outstanding rejections in the present application is also respectfully requested based on the following remarks.

I. THE OBVIOUSNESS REJECTION OF CLAIMS 1, 4-12, 16-18, 22-29 AND 42-45

On page 2 of the Office Action, claims 1, 4-12, 16-18, 22-29 and 42-45 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 5,590,107 to Chen *et al.* (“Chen”) in view of U.S. Publication No. 2002/0167890 to Duroj (“Duroj”), and in further view of U.S. Patent No. 6,957,334 to Goldstein *et al.* (“Goldstein”). These rejections are hereby respectfully traversed.

As stated in MPEP § 2143.03, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). That is, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” In re Wilson, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970).

Claims 1, 12, 18, 24 and 42 have been amended to recite a transaction “utiliz[ing] at least a portion of the optically encoded personal information in conjunction with security information stored in an alternative location on the carrier.” This amendment is supported at least by page 3, lines 11-16 of the specification of the present application. Claims 1, 12, 18, 24 and 42 have been further amended to recite “wherein an authentication process limits the user to a predetermined

number of authentication attempts.” This amendment is supported at least by lines 5-12 of page 15 of the specification and Figure 11 of the present application.

Regarding claim 1, the Examiner asserts that Chen in view of Duroj and in further view of Goldstein discloses the claimed invention. *See* Action, page 2. Applicant respectfully disagrees.

Claim 1 recites “a processor including browsing tools for allowing a user to view and select items and transaction tools for allowing a user to complete a transaction, wherein a transaction utilizes at least a portion of the optically encoded personal information in conjunction with security information stored in an alternative medium on the carrier.” (Emphasis added). As admitted by the Examiner, “Chen does not explicitly teach the encoded information carrier is an optically encoded information carrier.” *See* Action, page 7. Chen, at best, discloses “a tamper resistant portable electronic storage medium such as a smartcard ...” *See* Chen, column 4, line 67 - column 5, line 1. The Examiner, however, alleges that paragraphs 1-3 and paragraph 11 of Duroj disclose storing information using alternative technology. Duroj, as cited, refers to CDs and DVDs. There is no disclosure or suggestion of “utiliz[ing] at least a portion of the optically encoded personal information in conjunction with security information stored in an alternative medium on the carrier [for a transaction].” Chen, Duroj, and Goldstein either singly or in combination, fail to disclose “a processor including browsing tools for allowing a user to view and select items and transaction tools for allowing a user to complete a transaction, wherein a transaction utilizes at least a portion of the optically encoded personal information in conjunction with security information stored in an alternative medium on the carrier.” Thus, the Examiner has failed to disclose all of the elements of independent claim 1.

Furthermore, claim 1 recites “an authentication process limits the user to a predetermined number of authentication attempts.” Chen, Duroj, and Goldstein, either singly or in combination, fail to teach or suggest “the authentication process limit[ing] the user to a predetermined number of authentication attempts.”

Claims 12, 18, 24 and 42 contain similar limitations to claim 1 and are thus allowable for at least the above reasons.

Additionally claims 10, 11, 16, 17, 22, 23, 28, 29 and 45 recite a “securing mechanism” that is not disclosed by Chen, Duroj or Goldstein. For example, claim 10 recites “securing mechanism for securing the card in the optical input/output device.” Claim 11 recites “securing mechanism for securing the card in the optical input/output device.” Claims 16, 17, 22, 23, 28, 29 and 45 contain similar recitations. The Examiner alleges that the securing mechanism of claims 10 and 28 is taught by Chen modified by Duroj. See, Action, page 4. To support this allegation the Examiner cites Chen column 5, lines 20-34 and column 6, lines 21-27. The cited portions of Chen refer to inserting smartcards into card readers, not a “securing mechanism for securing the card in the optical input/output device.” As admitted by the Examiner, “Chen does not explicitly teach ... the input/output device is an optical input/output device.” See Action, page 5. Thus, since Chen is admitted by the Examiner not to teach the use of an optical input/output device, citations to Chen cannot possibly disclose or teach a “securing mechanism for securing the card in the optical input/output device.” Thus, the Examiner has failed to point to any teaching or disclosure in Chen or Duroj of a “securing mechanism for securing the card in the optical input/output device.” With regards to claims 11 and 29, the Examiner simply cites a smaller subset of the same portions of Chen. Claims 16, 17, 22, 23 and 45 are also rejected

relying of the same citations to Chen. None of the citations can possibly disclose a “securing mechanism for securing the card in the optical input/output device” because as admitted by the Examiner “Chen does not explicitly teach ... the input/output device is an optical input/output device.”

Furthermore, Duroj does not disclose a “securing mechanism for securing the card in the optical input/output device.” Duroj is related to “a storage card, for use together with a CD, DVD or similar device, with a rectangular shape that includes a circular segment for storing information.” Duroj, paragraph 1. The Examiner fails to point to any disclosure in Duroj of a “securing mechanism for securing the card in the optical input/output device.” As clarified by the specification of the present application, “outwardly extending dimples (not shown) could be provided for securing a base of the carrier 10 into the CD-ROM drive. Such a securing mechanism could comprise three or four dimples each positioned a selected distance from the center of the carrier.” *See* specification, page 11, lines 6-8. Clearly a “securing mechanism for securing the card in the optical input/output device” is not disclosed by a reference to a smartcard reader of Chen or by rectangular cut CD or DVD. Goldstein fails to remedy these deficiencies. The Examiner has thus failed to disclose all of the elements of claims 10, 11, 16, 17, 22, 23, 28, 29, and 45. Thus, the Examiner has failed to establish a *prima facie* case of obviousness.

Claims 2-11, 13-17, 19-23, 25-29, and 43-45 depend from independent claims 1, 12, 18, 24, and 42 respectively and thereby incorporate the respective limitations of the independent claims. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Accordingly, claims 2-11, 13-17, 19-23, 25-29, and 43-45 should be allowable at least by virtue of their dependency on the independent claims.

For at least the foregoing reasons, it is respectfully requested that the aforementioned obviousness rejection of claims 1, 4-12, 16-18, 22-29, and 42-45 be withdrawn.

II. THE OBVIOUSNESS REJECTION OF CLAIMS 2-3, 13-15 and 19-21

On page 8 of the Office Action, claims 2-3, 13-15, and 19-21 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 5,590,107 to Chen *et al.* (“Chen”) in view of U.S. Publication No. 2002/0167890 to Duroj (“Duroj”), in further view of U.S. Patent No. 6,957,334 to Goldstein *et al.* (“Goldstein”) and in further view of U.S. Patent No. 6,725,303 to Hoguta *et al.* (“Hoguta”). These rejections are hereby respectfully traversed.

It is respectfully submitted that the aforementioned obviousness rejection of claims 2-3, 13-15, and 19-21 has become moot in view of the deficiencies of the primary references (i.e., Chen, Duroj, and Goldstein) as discussed above with respect to independent claims 1, 14, and 20. That is, claims 2-3, 13-15, and 19-21 are dependent upon independent claims 1, 14, and 20, and thus inherently incorporate all of the limitations of independent claims 1, 14, and 20. Also, the secondary reference (i.e., Hoguta) fails to disclose, or even suggest, the deficiencies of the primary references as discussed above with respect to independent claims 1, 14, and 20. Thus, the combination of the secondary reference with the primary references also fails to disclose, or even suggest, the deficiencies of the primary references as discussed above with respect to independent claims 1, 14, and 20. Accordingly, claims 2-3, 13-15, and 19-21 should be allowable over the combination of the secondary reference with the primary references at least

by virtue of their dependency on independent claim 1, 14, and 20. Moreover, claims 2-3, 13-15, and 19-21 recites additional features which are not disclosed, or even suggested, by the cited references taken either alone or in combination.

For at least the foregoing reasons, it is respectfully requested that the aforementioned obviousness rejection of claims 2-3, 13-15, and 19-21 be withdrawn.

III. CONCLUSION

In view of the above, Applicant respectfully requests that the rejection of the claims specifically argued, as well as all claims dependent thereon, be reversed. Applicant respectfully submits that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

No fee is believed to be required for entry and consideration of this Reply. Nevertheless, in the event that the U.S. Patent and Trademark Office requires a fee to enter this Reply or to maintain the present application pending, please charge such fee to the undersigned's Deposit Account No. 50-0206.

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